

REMARKS/ARGUMENTS

Claims 1-20 are pending in the application.

Per Examiner's observations, a replacement Abstract and Replacement Drawing Sheets have been included in this Office Action response.

Claims 1 and 11 have been amended to add clarifying language to direct the invention to composite filters designed in *electronic circuits*. These changes are supported in the Specification and contain no new matter.

Claims 5 and 15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as his invention.

Claims 1-2, 4-6, and 9-18 are rejected under 35 USC §102(b) as being anticipated by Sawada et al (US6693501) hereinafter, "*Sawada*").

Claims 3, 7-8 and 19-20 are further rejected under 35 USC §103(a) as being unpatentable over *Sawada*.

The §112 Rejection

Applicant respectfully traverses the rejection. Claims 5 and 15 have support in the specification with respect to the features of "characteristic" and "selected." The characteristics refer to the. "filter *characteristics*, such as the order, bandwidth, stopband attenuation, and ripple magnitude," presented in Applicant's specification (Specification, Page 4, lines 3-4). Furthermore, "for filters 202, 204 are designed and *selected* in order to achieve minimal passband ripple and maximum stopband rejection in composite filter 200 (Specification, page 4, lines 4-5)."

Thus, these terms have sufficient support in the Specification. It should be noted that not everything necessary to practice the invention need be disclosed. All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art." See *In re Buchner*, 929 F. 2d 660,661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991).

Therefore, Applicant requests that the §112 rejection be withdrawn.

The §102 Rejection

Applicant respectfully traverses the §02 rejection. In reviewing *Sawada*, Applicant notes that “In order to overcome the above-described problems, preferred embodiments of the present invention provide a SAW apparatus including a first SAW filter device having a plurality of interdigital electrodes (interdigital transducers, which are hereinafter referred to as “IDTs”) provided on a piezoelectric substrate along a direction in which a SAW propagates, and a second SAW filter device including a plurality of IDTs provided on the piezoelectric substrate along a direction in which a surface acoustic wave propagates (col. 2, lines 25-32).”

In stark contrast to *Sawada*, Applicant’s claimed features are directed toward “a composite filter comprising *an electronic circuit* including at least two cascading filters.” Consequently, *Sawada* does not anticipate Applicant’s claimed features.

Per MPEP §2131:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently describe in a single prior art reference.” *Verdgaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). **The identical invention must be shown in as complete detail as contained in the . . . claim.”** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). **The elements must be arranged as required by the claim.**

In view of the foregoing, Applicants respectfully assert that the rejections under 35 USC 102(b) of are improper and should be withdrawn. In that independent claims 1 and 11 are not anticipated by *Sawada*, dependent claims 2, 4-6, and 9-18 are not anticipated, as well.

The §103 Rejection

By the discussion presented with respect to the §102 rejection, similarly *Sawada* does not teach or suggest Applicant’s claimed features. In addition, the Office Action concedes that “the at least one of the at least two cascading filters comprises a digital filter. . .” the features of claims 3 and 13, and those recited in claims 7-8 and 19-20. The Office Action has not presented a *prima facie* case of obviousness under §103. That the reference is silent on these recited claim features does not support the Office Action’s assertion that “as well known in the art” and “to be a matter of design expedient.” The particular technology discussed by *Sawada* teaches away from Applicant’s claimed features. See *In re Fine*, 873 F.2d 1071, 5 USPQ 2d 1596 (Fed Cir. 1988). Furthermore, the Federal

Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), there was a want of prima facie obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot be reasonably construed as an affirmative statement that [the requirement is in the reference].

In view of the foregoing, Applicants respectfully assert that the rejections under 35 USC 103(a) are improper and should be withdrawn. Thus, claims 3, 7-8 and 19-20 are allowable over the cited reference.

Conclusion

Applicant believes he address the Examiner's concerns. A Notice of Allowance is earnestly requested.

Please charge any fees other than the issue fee and credit any overpayments to Deposit Account 50-4019.

Respectfully submitted,

Date: 2007-APR-18

By /Peter Zawilski/
Peter S. Zawilski, Reg.No.43,305
(408) 474-9063

Correspondence Address:
NXP, B.V.
Intellectual Property Department
(formerly Philips Electronics North America Corporation)
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131 USA

CUSTOMER NO. 65913